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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,362	02/02/2001	Donald W. Taylor	DE007DT-1	1840

7590 03/31/2004

ORSCHELN MANAGEMENT CO  
2000 US HWY 63 SOUTH  
MOBERLY, MO 65270

EXAMINER
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RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/776,362

Applicant(s)

TAYLOR ET AL.

Examiner

Umakant K. Rajguru

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-4,6-8,10,11,13-18,21-28 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6-8,10,11,13-18,21-28 and 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. An RCE has been filed on Nov 28, 2003
2. Claims under examination are 2-4, 6-8, 10, 11, 13-18, 21-28 and 30-37.
3. All earlier rejections of above claims in parent application are now withdrawn.
4. Claims 4 & 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 4 depends from claim 2. Claim 2 encompasses grafted EPDM. Claim 4 also encompasses EPDM.

Same is the case with claim 11.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 2-4, 6-8, 10, 13-15, 21-24, 26-28 and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al (US 4600635) in view of Heimann et al (US 647857).

Wiercinski discloses bitumen- based adhesive compositions. These compositions can be adhered to a substrate in the form of layers. A support layer of polymeric sheets (col. 1, lines 13-32) and various woven or nonwoven backings are provided.

Composition comprises ionomeric elastomers (col. 6, lines 44-59) and EPDM terpolymers (col. 7 lines 10-20).

Wiercinski does not mention (claimed) passivating agent of instant claim 1 and polyme/s of instant claim 10.

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Heimann discloses corrosion resistant lubricants, greases and gels. The grease includes silica/silicate mixture (abstract; col. 3, line 62 to col. 4, line 7). Calcium silicate is a suitable silicate (col. 6, lines 37-38). Patentee also discloses use of other additives such as polyethylene, polyvinylidene difluoride, polytetrafluoroethylene and polyvinyl chloride in col. 26, lines 15-19 which are considered as reinforcements.

Therefore it would have been obvious to use calcium silicate, other additives as well as any of the polymers of Heimann in the composition of Wiercinski in order to increase pH and thereby enhance corrosion resistance.

7. Claim 11 is under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al (US 4600635) in view of Heimann et al (US 6017857) as applied to claims 3 & 10 above, and further in view of Vogel et al (US 6528174).

Prior does not mention ethylene vinyl acetate.

Vogel discloses composition comprising ethylene vinyl acetate (col. 1, lines 16-26).

It would have been obvious to add ethylene vinyl acetate copolymer to the composition of Wiercinski in order to impart toughness, flexibility and adhesion.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al (US 4600635) in view of Heimann et al (US 6017857) as applied to claim 2 above, and further in view of Glorieux (US 5399189).

Glorieux discloses anticorrosive protective composition for metals. According to patentee, use of polymer micro parts (such as Expancel) considerably improves corrosion resistance (col. 2 lines 21-31).

Therefore it would have been obvious to add an expansion agent to the composition of Wiercinski to ensure complete surface-to-surface contact between the substrate (on which adhesive tape is applied) and the adhesive.

9. Claims 17 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al (US 4600635) in view of Hemann et al (US 6017857) as applied to claim 2 above, and further in view of Karim et al (US 6057383).

Prior art does not mention thermosetting compound, curing agent, curable polymer and photoinitiator.

Karim discloses photocurable adhesive (abstract; col. 1, lines 55-67).

It would have been obvious to include photocurable resin and photoinitiator in the composition of Wiercinski to impart sufficient tack even in cold uncured state, better adhesion to metal on curing and a controlled flow during curing.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al (US 4600635) in view of Heimann et al as applied to claims 21 & 23 above, and further in view of Weidenbenner et al (US 3908064).

Prior art does not mention dicyandiamide as curing agent.

Weidenbenner discloses a composition in preshaped tape form comprising an extruded article containing and epoxy resin and dicyandiamide curing agent.

It would have therefore been obvious to add dicyandiamide as a curing agent into the composition of Wiercinski to ensure complete cure at elevated temp into a tough & hard material.

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11. Applicant's reworks on pages 6-8 accompanying the amended claims filed in this RCE have been considered. They are however irrelevant since the examiner has now used prior art which is different from the one in the parent application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru, whose telephone number is (571) 272-1077. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



U. K. Rajguru/af  
March 18, 2004



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700